

**REMARKS**

**Summary of the Office Action**

In the Office Action, claims 1-11, 16, and 18-21 stand rejected under 35 U.S.C. §103(b) as allegedly being anticipated by U.S. Patent No. 5,554,094 to *Viens*.

The drawings are objected to for certain informalities.

Applicant respectfully traverses these rejections and objections for the following reasons.

**Summary of the Response to the Office Action**

Applicant amended the drawings to address the minor informalities objected to in the Office Action. Applicant amended independent claims 1 and 16 and added claims 31-33. Accordingly, claims 1-11, 16, 18-21, and 31-33 are pending for further consideration

**All Subject Matter Complies with 35 U.S.C. § 103(a)**

Claims 1-11, 16, and 18-21 stand rejected under 35 U.S.C. § 103(a) as obvious over *Viens*. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness and therefore all rejections under 35 U.S.C. § 103(a) should be withdrawn.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations. All three criteria must be met to establish obviousness.

The Office Action has not established a *prima facie* case of obviousness at least because *Viens*, does not teach or suggest all the recited features of independent claims 1 and 16. Namely,

*Viens* does not teach or suggest at least the “a folding mode . . . wherein a plurality of modes of folding can be applied on the sheet by a single sheet path,” features recited in claims 1 and 16.

*Viens* discloses a sheet folding apparatus with plural folding sheet paths that can be reconfigured to perform Z-folding, C-folding, and half-folding of sheets. The different configurations of the sheet paths are shown in Figs. 5A-5A, 6A-6B, and 7A-7B, respectively. The sheet path configurations are manually converted from one to another. See col. 1, lines 65-67 and col. 8, lines 48-52 of *Viens*. Thus, *Viens* teaches away from the present invention because *Viens* discloses an apparatus with multiple sheet path configurations that must be manually converted to enable the Z-folding, C-folding, and half-folding of a sheet. See col. 5, line 9 through col. 8, line 30 and Figs. 5A-5A, 6A-6B, and 7A-7B of *Viens*.

In the present invention, the letter Z-folding, letter C-folding, and Z-folding of sheets requires only a single configured sheet path. See page 12, lines 21-24 of the specification. All three types of sheet folding can be accomplished with the same sheet path configuration as seen in Fig. 3 of the specification.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). Therefore, Applicant respectfully asserts that the third prong of *prima facie* obviousness has not been met.

Applicant respectfully asserts that newly amended independent claims 1 and 16 are distinguishable over the applied art and that the rejections under 35 U.S.C. § 103(a) should be withdrawn. Additionally, claims 2-11, 18-21, and 31-32, which depend from independent claims

1 and 16, are allowable at least because their base claims are allowable, as well as for the additional features recited therein.

New independent claim 33 recites a combination features including a “sheet folding unit [that] includes a plurality of folding mechanisms in a sheet path.” As such, it is respectfully submitted that claim 33 is allowable for at least the same reasons as independent claims 1 and 16.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.


If there are any other fees due in connection with the filing of this Response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. §1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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MJB/DEC